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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/708,192

02/14/2004

Daniel Perlman

PER-002

2191

26918

7590

02/07/2006

WHITE & FUDALA
57 BEDFORD STREET
SUITE 103
LEXINGTON, MA 02420

EXAMINER

GIBSON, RANDY W

ART UNIT

PAPER NUMBER

2841

DATE MAILED: 02/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/708,192	Applicant(s) PERLMAN, DANIEL	
	Examiner Randy W. Gibson	Art Unit 2841	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-18 is/are allowed.
- 6) ☒ Claim(s) 19-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed January 20, 2006 have been fully considered but they are not persuasive with respect to all of the claims. Applicant argues that the method, which is a new use for an old product, is non-obvious and these arguments are persuasive. However, applicant has admitted in his arguments that the product itself is old since it is used for chocolate candy wrappers. The product claims 19-22 cannot be allowed based on applicant's own admission of prior art. See *MPEP* § 2129.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(f) he did not himself invent the subject matter sought to be patented.

3. Claims 19-22 are rejected under 35 U.S.C. 102(f) because the applicant did not invent the claimed subject matter. Applicant has admitted in his arguments that the product itself already exists and has been used by the candy industry as candy wrappers. See *MPEP* § 2129.

Claim Rejections - 35 USC § 103

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claim 19 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Hamilton (US # 2,459,073). Hamilton shows in figures 6-9 the paper cup as illustrated and claimed. Although Hamilton does not expressly state that his cup is formed with a surface that is “lubricious and substantially impermeable” to powder, the examiner notes that the paper cup is most likely formed from wax paper to prevent it from leaking, since the cup is intended to hold liquid. If not inherently present, since wax paper was a commonly used material to form paper drinking cups from, it would have at least been obvious to place a wax coating on the inside of the cup of Hamilton to prevent it from leaking.

Hamilton also does not expressly state that his cup has been sterilized; however, it would have been obvious to the ordinary practitioner to sterilize the cup at the factory to prevent the spread of disease, especially if the cup was originally intended to be used in a medical or dental facility.

As for the preamble recitation that this cup is intended to be used to hold powder while it is being weighed, the examiner notes that a preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to

stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976); *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951); and, **MPEP** § 2111.02.

6. Claims 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hamilton (US # 2,459,073) in view of Gebo et al (US # 4,878,552) and Marx et al (US # 4,606,496). Hamilton shows in figures 6-9 the paper cup as illustrated and claimed. Hamilton does not show his cup being placed on a scale in order to hold fluent material to be weighed. Gebo et al show (Figures 1, 3, 7 & 8) a cup placed on a weighing scale to hold fluent material while it is being weighed. It would have been obvious to use any standard paper cup, such as the cup of Hamilton, to hold fluent material, such as powder, while it is being weighed.

Although Hamilton does not expressly state that his cup is formed with a surface that is "lubricious and substantially impermeable" to powder, the examiner notes that the paper cup is most likely formed from wax paper to prevent it from leaking, since the cup is intended to hold liquid. Also, Marx et al shows that it was well known to give paper ware a waterproof coating to prevent the paper from absorbing liquids and falling apart (Col. 1, lines 14-25). If not inherently present, it would have at least been obvious to place a waterproof coating on the inside of the cup of Hamilton, as suggested by Marx, to prevent it from leaking.

As for the preamble recitation that this cup is intended to be used to hold powder while it is being weighed, the examiner notes that a preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended

use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976); *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951); and, **MPEP** § 2111.02.

Hamilton also does not expressly state that his cup has been sterilized; however, it would have been obvious to the ordinary practitioner to sterilize the cup at the factory to prevent the spread of disease, especially if the cup was originally intended to be used in a medical or dental facility. As for the specific method of sterilization mentioned in claim 3, the examiner notes that using a well known method of sterilization would have been obvious motivated by its art recognized suitability for its intended use. See **MPEP** § 2144.07.

As for the claim limitations of the specific angle of the spout, the specific dimensions of the bottom & sidewalls of the cup, and the thickness & type of the paper that the paper cup is made from, the examiner notes that paper cups customary come in a variety of sizes (I.E.: large, medium, small, etc.); it would have been obvious to manufacture the cup to whatever size, spout angle, or paper thickness specified by its target market (I.E.: bathroom use, picnic use, kitchen use, etc.).

As for the claim limitations of how the paper cup is made, the examiner notes that forming paper ware using a mechanical pressure mold is known as disclosed by Marx, and it would have been obvious to manufacture the cup of Hamilton using a technique that was art recognized as being suitable for this very purpose. See **MPEP** § 2144.07.

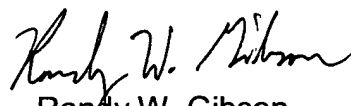
Conclusion

7. Claims 1-18 as amended are allowable over the art of record.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Randy W. Gibson whose telephone number is (571) 272-2103. The examiner can normally be reached on Mon-Fri., 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kamand Cuneo can be reached on (571) 272-1957. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Randy W. Gibson
Primary Examiner
Art Unit 2841